

REMARKS

Claims 1-31, as amended above, remain in the application for further prosecution.

Drawings

The updated sheet, sheet 5/8, is being resent and is attached to this Amendment. The drawing change occurs on FIG. 8 and that change has been outlined in red. In FIG. 8, previously omitted element 42—the slot machine symbol 42—has been added. Support for this drawing correction can be found in the Applicants' specification at paragraph 21 and in FIG. 11. The Applicants respectfully submit that this drawing amendment does not add new matter to the present application.

A replacement set of formal drawings is also being submitted.

The Previous Arguments

The Applicants firmly believe that present claims are patentable over Moody and Schneider, as discussed in detail below. The Applicants set forth its positions regarding Moody and Schneider in the Reply to the Office Action dated August 23, 2004. When filing the RCE on October 21, 2004, the Applicants requested the Examiner to review those arguments from the Reply to the Office Action dated August 23, 2004 as they were pertinent to the clarifying amendments in the RCE.

In this recent Office Action dated March 11, 2004, the Examiner states "Applicant's arguments filed 3-26-2004 have been fully considered but they are not persuasive." Office Action, p. 9 (emphasis added). The Office Action further states "previously presented arguments submitted with the filing of the above cited after final may be found in the Advisory Action mailed 9-23-2004." Office Action, p. 10. The Advisory Action, however, did not address the Amendments from the RCE.

In short, it is unclear whether the Examiner considered the arguments set forth on August 23, 2004 in light of the amended claims submitted with the RCE.

Double Patenting

Claims 1-31 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over certain claims of U.S. Patent No. 6,800,027.

To overcome this rejection, a Terminal Disclaimer is submitted herewith. This Terminal Disclaimer should not be construed as an admission to the merits of the obviousness-type double-patenting rejections pursuant to Quad Environmental Technologies Corp. v. Union Sanitary District, 946 F.2d 870 (Fed. Cir. 1991).

§§ 102 and 103 Rejections

Claims 1-9 and 11-19 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,976,016 (Moody et al).

Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,976,016 (Moody et al) as applied to claims 1 and 11 above, and further in view of U.S. Patent No. 6,089,976 (Schneider et al).

Claims 21-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,089,976 (Schneider et al).

Claims 1 and 11

Claims 1 and 11 were again rejected under 35 U.S.C. § 102(b) as being anticipated by Moody. The Applicants respectfully request the Examiner to reconsider this rejection.

Before engaging in the detailed distinctions between Moody and the claims, Applicants respectfully request the Examiner to review FIGS. 3-8 of the present application, and to read the corresponding text at paragraphs 17-21 in the published application. The Applicants respectfully request the Examiner to then consider the **substantial** difference between the Applicants' invention and Moody's symbol-replacement feature that occurs on Moody's pay lines.

Claims 1 and 11 require "displaying a plurality of selectable elements, **each one** of the plurality of selectable elements **being associated** with **a corresponding one** of a plurality of respective outcomes." (emphasis added) As such, there is a direct, one-to-one relationship between each selectable element and its corresponding outcome. One example of this

arrangement can be readily seen in FIGS. 3-8, especially FIG. 6 where two outcomes ((i) the Orange 40, which results in a further chain-reaction in FIG. 7, and (ii) 10 credits) are associated with two elements 30g and 30f. When considering the present invention, these two elements are “selectable elements” and, depending on how the player make his or her selections, could become “selected” elements if the player selects them or “non-selected elements” if the player does not. In the illustrated example, the player selects selectable element 30c (FIG. 4) so that the two elements 30g and 30f are non-selected elements, as those terms are used in the claims.

In addition to the “displaying” limitation discussed above, the last element of claims 1 and 11 requires “awarding to the player the outcomes associated with the selected element and the at least one of the non-selected elements.” (emphasis added) In other words, claims 1 and 11 require that at least two outcomes be awarded: one associated with the selected element and one associated with the non-selected element. This is the “chain-reaction” feature that is indicated in the specification and the title.

Moody does not teach these claim elements of claims 1 and 11. In presenting the basis for the rejection, the Examiner states that the one correlation of Moody to claims 1 and 11 is that the “selectable elements” correspond to Moody’s “symbol positions” and that the “corresponding one of the respective outcomes” corresponds to Moody’s “symbols” randomly selected for the symbol positions. The Applicants believe that this is an improper construction of claims 1 and 11. But, even when considering the Examiner’s proposed construction, Moody’s system would never perform the act of “awarding to the player the outcomes associated with the selected element and the at least one of the non-selected elements.” How would Moody’s player ever be awarded “the symbols,” which the Examiner has construed to be the “outcomes?” For example, Moody’s player is not “awarded” the Star symbol or Moon symbol in FIG. 3. Rather, the player is awarded a monetary payout in accordance with a pay table, if “winning symbol combinations” are achieved. Moody’s teaching about “winning symbol combinations” (also shown in Table I on column 4) is also important as it shows Moody does not teach a selectable element having a corresponding outcome. As such, a *prima facie* case of anticipation is lacking for these reasons.

Additionally, the Examiner is of the opinion that the “selected outcomes” correspond to one of the pay lines and the “non-selected outcomes” correspond to other ones of the non-selected pay lines, such as pay lines “(320, 340).” See Advisory Action, paragraph 2, last sentence. But, to achieve an award associated with the pay lines 320, 340, the player **must select** that pay line 320, 340 and place a wager on it. See Col. 2, lines 35-40 (“After the player has selected the number of pay lines that the player wishes to play, ...) Hence, how could any of pay lines 310, 320, 330, 340, 350 be considered “non-selected elements” resulting in “non-selected outcomes” when the player **must select** those pay lines?

Considering this position on the “selected” and non-selected” pay lines recited in the previous paragraph and reviewing claims 9 and 19, it is unclear how the Examiner finds a “matrix” of selectable elements with a plurality of rows and a plurality of columns. If entire pay lines 320, 340 are considered “non-selected elements,” then it is impossible to find a matrix of a selectable elements with a plurality of rows and **a plurality of columns**.

Further, claims 2 and 11 require “revealing the outcomes associated with the selected element and the at least one of the non-selected element at their respective locations” in response to the selection. Moody does not disclose that an outcome associated with a symbol is revealed at a symbol location in response to selection of that symbol. Moody does **not** even disclose that each symbol is associated with an outcome, and Moody’s symbols are known to a player at the time of selection. Thus, the Applicants respectfully submit that claims 2 and 11 are patentable over Moody for at least this reason as well. It should be also noted that the Office Action, when rejecting claims 2 and 11, **fails to mention anything** about “revealing.”

In summary, claims 1-20 are patentable over Moody.

Claims 21, 26, and 31

A brief review of the prosecution of claims 21-31 is necessary. Claims 21-31 were rejected two different times based on Schneider under § 102. In response to the Advisory Action which maintained the rejection under § 102, the Applicants amended claims 21, 26, and 31 to further distinguish Schneider. The amendments to these claims focused on **substantial** differences between the claimed invention and Schneider.

In response to those amendments in the RCE, with the exception of the last few sentences in the last paragraph on page 8 of the current Office Action focusing on claims 21 and 26, the Examiner has copied and pasted the same arguments that the Examiner previously used with respect to the rejections under § 102, and now states the rejection is based on § 103. In doing so, **the Examiner does not address any of the newly added claim amendments that were included in the RCE.** As such, a *prima facie* case of obviousness fails for this reason alone as the Examiner is required to set forth the claim limitations as they are allegedly found in the cited prior art.

In the only other comment on claim 21-31, the Examiner states, “these features also **seem at this point** to utilize the same game mechanics as taught by Schneider merely rearranged.” Office Action, p. 10. The Applicants strongly object to this statement for two reasons. First, the obviousness standard is not whether a prior art reference “seems” to render a claim obvious. The prior art reference must render the claim obviousness and the basis for the rejection must be set forth in detail. See MPEP §§ 2142 & 2143. And second, in this case, the claimed invention is not a mere rearrangement of Schneider.

It is improper to ignore definitions that are commonly known to those of skill in the art. The Office Action still attempts to read Schneider on the present claim by swapping Schneider’s primary game and Schneider’s secondary game. This construction is improper because it ignores commonly accepted terminology used in wagering-game patents. Skilled artisans surely understand what a “primary game” is and what a “secondary game” is. Not only does the present specification make this clear, but even Schneider uses the same language to refer to the same types of games. In the Abstract, Schneider describes his primary game:

A gaming apparatus and method including a primary game and a player interactive bonus game actuated by a qualifying outcome of the primary game and including a bonus award display showing a multiplicity of images displayed on a video monitor from which a player selects until achieving a pair of matched bonus awards

Later, in the Background section, Schneider discusses the prior art:

For example, the patent to Marnell, II (U.S. Pat. No. 5,393,057) teaches the use of a poker game or reel game for the primary game and a bingo type game as a secondary game. Certain outcomes

from the primary game are reflected in the secondary game and, upon the occurrence of orienting the reflected values from the first game to the second game in a pre-agreed upon pattern (resulting in bingo), a secondary award is made to one or more players responsible for the "bingo". Thus, these types of games also fail to maintain player stimulus as a result of the player being a passive observer of the secondary game."

The Applicants respectfully request the Examiner to reconsider this 103 rejection as the Examiner's construction is directly at odds with (i) the present specification, (ii) the applied prior art, and (iii) commonly accepted language that is used throughout wagering-game patents.

Furthermore, as mentioned generally above, once the Examiner modifies Schneider by swapping Schneider's primary game and secondary game, the Examiner has still failed to establish that all of the claims elements are present in the claims. For example, claims 21, 26 and 31 require a the primary game to have a "plurality of randomly selected primary-game outcomes" and one of those randomly selected primary-game outcomes is a "start-secondary outcome," which causes the secondary game to start. Even if it were acceptable to swap Schneider's primary game and secondary game to reject claims 21, 26, and 31, when doing so, one cannot find such a start-secondary outcome in Schneider in Schneider's "primary" game (as the Office Action alleges), which is really Schneider's secondary game. Again, FIG. 7 of Schneider simply highlights the fact that Schneider is no different from any other gaming machine -- the primary game can be played after the secondary game if the player makes another wager.

Furthermore, claims 21, 26, and 31 call for language that states "without requiring an additional wager." None of this language is addressed in the present Office Action. For example, claim 21 requires the primary game to be started and played "again" after achieving the start-primary game outcome in the secondary game and "without requiring an additional wager."

In summary, the Examiner cannot rely on the "mere rearrangement" argument when the proposed rearrangement does not teach all of the limitations of the claims. Furthermore, to the extent the Examiner feels compelled to reject these claims again, the Applicants respectfully request that the Examiner do so in a non-final Office Action that adequately addresses the issues listed above. If the rejections are to be based on Schneider, the Applicants have not been given a

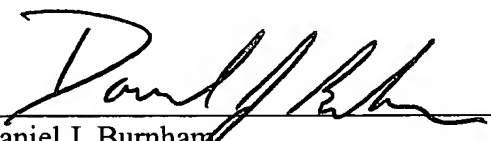
fair opportunity to traverse such a rejection because the full basis for the rejection, to the extent one exists, is not present in the Office Action. See MPEP § 707

Conclusion

If any matters may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact the Applicants' undersigned attorney at the number shown.

Respectfully submitted,

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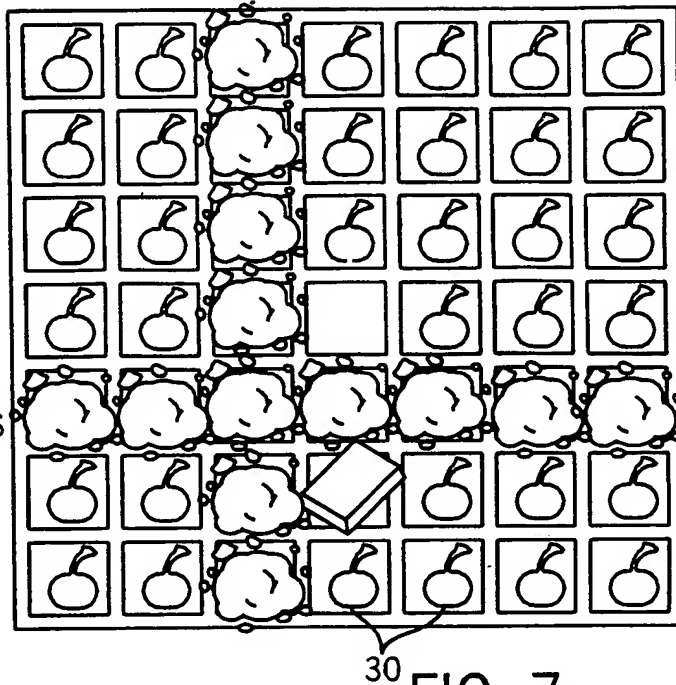
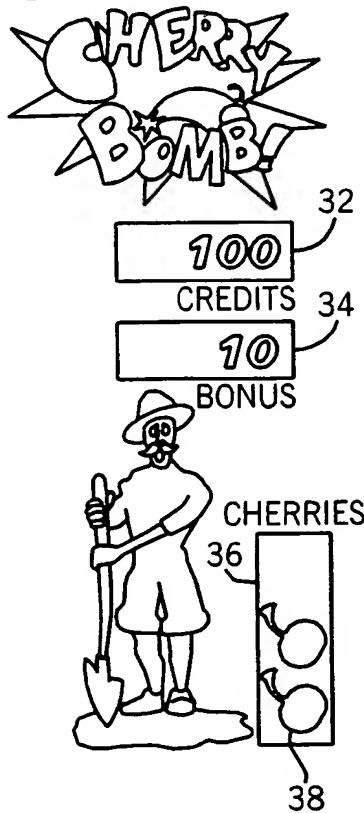


FIG. 7

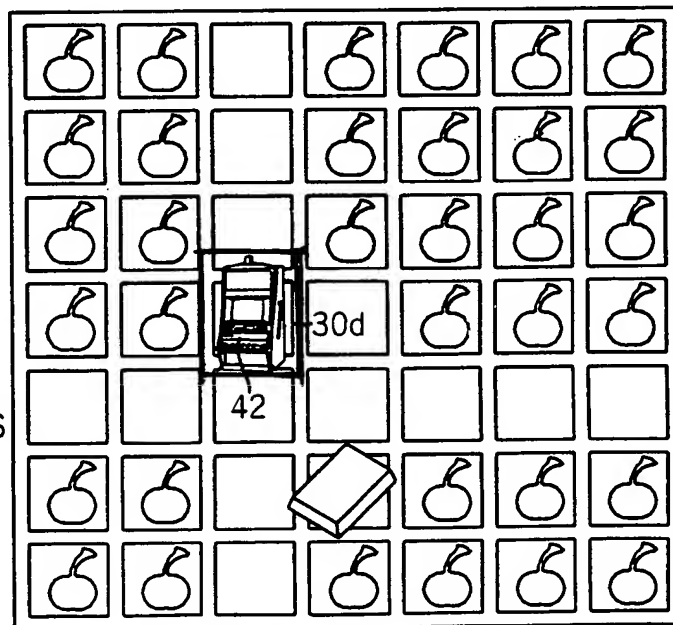
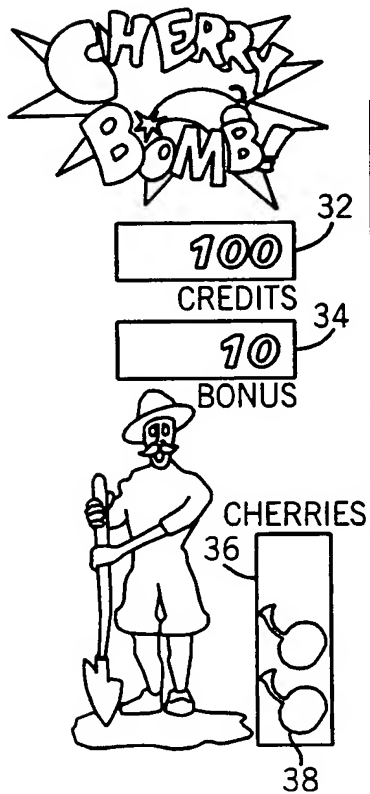


FIG. 8